

REMARKS

Claims 1 through 47 are pending the application. Claims 1, 2, 5, 21, 31, 34, 39 and 43 are hereby amended. New claim 47 has been added. Applicants respectfully traverse the rejections of the Office Action, mailed August 26, 2008, [hereinafter, "Aug. 26th OA"], and request reconsideration.

Summary of the Examiner Interview held telephonically on November 26th, 2008

An Examiner Interview was held on November 26th, 2008 telephonically between Examiner Jonathan G. Sterrett, Applicants' counsel Daniel Ho (Reg. No. 41,837), and Applicants' representatives Christopher P. Moreno (Reg. No. 38,566) and Joseph T. Cygan (Reg. No. 50,937), attorneys of record. Applicants wish to thank Examiner Sterrett for granting the Interview and taking time to discuss the claims and the Office Action of Aug. 26, 2008, [hereinafter "Aug. 26th OA"].

The Applicants discussed the Aug. 26th OA including the section addressing Applicants' May 12, 2008 arguments. The Applicants also discussed the section 101 and section 103 rejections and possible amendments to the claims to better clarify the claim scope over the references. No specific agreements were reached, however the Applicants agreed to provide proposed claim amendments for further discussion. Further details of the various topics discussed are included in the remarks herein below as appropriate.

Summary of the Examiner Interview held telephonically on December 22nd, 2008

An Examiner Interview was held on December 22nd, 2008 telephonically between Examiner James Sterrett and Applicant's representative Joseph T. Cygan, (Reg. No. 50,937), attorney of record, and Applicants again wish to thank the Examiner for taking time to discuss the claims.

A proposed amendment to independent claim 5 was discussed, and the Examiner agreed that such amendment would distinguish the claim over the Lawlis reference. The Applicants agreed to amend the other independent claims consistent with the claim 5 amendment as proposed. The instant amendment therefore provides the claim amendments in accordance with the discussion.

Summary of the Aug. 26th OA rejections

Claims 1-30 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. See Aug. 26th OA, page 12, ¶ 4.

Claims 1-10, 13-20, 31-33 and 43-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis, et al.; “A Formal Process for evaluating COTS Software Products”, (C) 2001 IEEE, Computer, pp. 58-63 [hereinafter “Lawlis”]. See Aug. 26th OA, page 14.

Claims 11, 12, 21-30, 34-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Murphy, Cheryl; “An evaluation format for “open” software tools”, 1995, Computers in Human Behavior, v11, No. 3-4, pp. 619-631, [hereinafter “Murphy”] and further in view of Matthew Owen Howard, R. Dale Walker, Patricia Silk Walker, Richard T. Suchinsky; “Alcohol and drug education in schools of nursing”, Journal of Alcohol and Drug Education. Lansing: Spring 1997. Vol. 42, Iss. 3; pg. 54, 27 pgs, [hereinafter “Howard”]. See Aug. 26th OA, page 21, ¶ 3.

Regarding the claim rejections under 35 U.S.C. § 101

The Applicants respectfully noted during the telephonic Examiner Interview of Nov. 26th, 2008, that the Office Action contained some typographical errors on page 13 regarding the claim language. Therefore the Applicants disregard this material and address the substance of the section 101 rejection. Although the Applicants presented their position regarding the section

101 rejection during the Nov. 26th discussion, no agreement was reached. Therefore the Applicants present their reasoning again here, and respectfully request reconsideration.

Regarding the Aug. 26th OA's recitation of case law and statement that "to qualify as a statutory process under § 101, the claims should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the material that is being changed to a different state)," the instant claims do in fact relate to transformation of data. See Aug. 26th OA, page 13. For example, the educational product evaluation method of claim 1 operates on specific data that provides a representation of an educational product and, by applying the method, transforms the data into an output that represents the analyzed educational product data and provides an indication of whether such an educational product meets the business organizations goals with respect to employee training defined by business goal rule data stored within a system. Therefore, the method and apparatus as claimed transforms data representing a specific tangible object, one or more educational products, and provides a transformation of that specific tangible object data in the analysis output.

Reconsideration and withdrawal of the 35 U.S.C. § 101 rejection is respectfully requested.

Regarding claim rejections under 35 U.S.C. § 103

Independent claims 1,5, 21, 31, 34, 39 and 43 have been amended to include language that Applicants believe better clarifies the claimed subject matter, and in accordance with the proposed claim 5 discussed between the Applicants and the Examiner on Dec. 22, 2008. For example, claim 1 as amended includes "*analyzing an educational product, wherein an education product includes an instructor led face-to-face course, a self-study course or a virtual course,*

based on the stored business goal rule data; and displaying an education product summary indicating an alignment of said educational product to said business organization's goals with respect to employee training."

Claim 5 as amended now recites that the business goal rule data *represents* a business organization's goals with respect to employee training, and *a plurality of educational product alignment values, for indicating the alignment of each educational product to said business organization's goals with respect to employee training, . . . wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area . . . and . . . wherein said plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course*. The other independent claims have been amended to comport as much as possible with the language of claim 5 as amended.

Applicants believe that the cited references, and specifically Lawlis, do not disclose the features of the independent claims. The Examiner has agreed with this assertion, at least with respect to claim 5.

Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of all the independent claims is respectfully requested in light of the above. Likewise withdrawal of the 35 U.S.C. § 103(a) rejection of the dependent claims is respectfully requested based on the amendments made herein to the independent claims. New claim 47 is a dependent claim that depends from claim 5 and further defines the rules included in the business goal rule data. Allowance of claim 47 is respectfully requested.

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Respectfully submitted,

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